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In the Supreme Court of the United States.

OCTOBER TERM, 1905.

EX PARTE AUTOMATIC SWITCH COMPANY, OF BALTIMORE CITY.

Original. No. —.

BRIEF IN OPPOSITION TO MOTION.

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In the Supreme Court of the United States.

Ex Parte Automatic Switch Company, of Baltimore City.

Original. No. —.

BRIEF IN OPPOSITION TO MOTION.

From the statement of the case, it appears that an interlocutory decree was entered in the Circuit Court, from which, under section 7 of the Act of June 6, 1900, an appeal was taken to the Circuit Court of Appeals of the Second Circuit.

Thereafter the Switch Company obtained the entry of what is *called* a final decree dismissing the Bill in part and thereupon appealed from that decree.

The Cutler Hammer Company moved to dismiss this appeal on the ground that it was in reality an appeal from an interlocutory decree.

After due consideration, after oral argument and on briefs, the Circuit Court of Appeals dismissed the appeal of the Automatic Switch Company.

The dismissed appellant seeks to reverse this action of the Circuit Court of Appeals by the instrumentality of a writ of mandamus or certiorari and has filed motion for leave to file a petition for a writ of mandamus or certiorari.

While it is the proper practice to file a motion for leave to file a petition for writ of mandamus, it is believed to be quite unusual to file a motion for leave to file a petition for a writ of certiorari.

This motion cannot be treated as a petition for a writ of certiorari because it lacks essential requisites of such a petition, the principal being that the whole record is not presented. The notice required has also not been given.

ARGUMENT.

This is one more of the numerous efforts to use the writ of mandamus in place of an appeal.

If there is a settled rule in this court, it is that such use may not directly or indirectly be made of this writ.

Ex parte Schwab, 98 U. S., 240.
Ex parte Perry, 102 U. S., 186.

But there is a graver difficulty in this case:

The court has *acted* and while mandamus may be used to compel action, it can never be used to reverse action or to control judicial discretion.

See cases *supra*.

The remedy of the moving party is ample.

There is, as yet, no final decree below.

Either the pending appeal of the Cutler Hammer Company can reach only the injunction and when there shall have been an accounting and a true final decree, an appeal can be taken therefrom, and on that appeal the whole record will be open for review, or upon the pending appeal, the whole case can be considered and a mandate issued ac-

cordingly; ultimately there will be a final decree in the Circuit Court from which appeal can be taken to the Circuit Court of Appeals and *that final decree* can be reviewed here on certiorari, if a proper case is made.

Thus the consideration of causes on the merits piecemeal will be avoided.

If the motion could be considered as an application for a writ of certiorari the writ could not be granted, because:

A. The application is fatally incomplete, lacking the whole record:

B. There is no final decree, indeed no decree at all, of the Circuit Court of Appeals.

Smith *vs.* Vulcan Iron Works, 165 U. S., 518.

In its last analysis, this is a case in which the application for mandamus is *too late* and for certiorari *too early*.

Amer. Constrc. Co. *vs.* Jacksonville Ice Co., 148 U. S., 372.
In re Transport Co., 168 U. S., 583.
In re Massachusetts, 197 U. S., 482.
In re Glaser, 198 U. S., 171.

AS TO THE MERITS.

While we believe the motion of the Automatic Switch Company should be denied, for the reasons above stated, we submit herewith for the guidance of the court, should it wish to investigate the merits of the petition, the following considerations, showing that in view of the facts of this case, the relief sought should not be granted.

I.

The petition and the brief in support thereof, are based upon two misconceptions or misstatements as to the record and facts in this case.

(1.) The petition and brief assume that the first interlocutory decree entered April 20, 1905, found claims 6, 7 and 8, *not infringed* (page 3 and page 10). As a matter of fact, however, the interlocutory decree of April 20, 1905, found claims 4, 5, 6, 7 and 8, valid and claims 4 and 5 infringed, but made no finding as to claims 6, 7 and 8 *with respect to infringement*. This misconcept on or misstatement has an important bearing upon the moving party's position as will hereafter appear.

(2.) The petition and brief state that the *entire record* had been taken to the Court of Appeals by defendant *before* the appeal by complainant (page 3, page 4, 16, 17 and 19).

As a matter of fact at the date of complainant's appeal no transcript and no printed record had been made up. After complainant's appeal, pursuant to the practice of the court requiring each party to pay one-half the expenses of the appeal when both appeal, a stipulation was made providing that each party should furnish the necessary copies of its printed record, the additional expenses to be paid half and half. At the date, therefore, of complainant's appeal, there was *not* a *complete* record taken up by defendant upon which a cross appeal could be based or, in fact, any record.

II.

Three theories as to the nature of the two decrees have been presented by the opposing parties.

(1.) It is the position of the respondent to the motion that the decree of April 20, 1905, and the decree of May 26, 1905, are both interlocutory decrees.

(2.) It was the main contention of the moving party at the argument of the motion to dismiss the cross appeal that the first decree was interlocutory, while the second decree was final.

(3.) It appears to be the main contention of the moving party herein, that both decrees are interlocutory but constitute in effect a single decree.

It is submitted that the first of the above theories is the only one which is tenable.

III.

The chronology of events concerning the two appeals is as follows :

April 20, 1905, first decree entered and filed.

May 12, 1905, appeal by defendant from first decree.

May 13, 1905, citation to complainant.

May 26, 1905, second decree, so called "final" decree, entered and filed.

June 7, 1905, appeal by complainant from second decree.

June 9, 1905, transcript of record, containing documents specified by both parties, filed.

IV.

We submitt the following controlling propositions which are established by the authorities and the record in this case.

(1.) *The first decree entered April 20, 1905, is interlocutory.* This fact is not disputed. The decree,

"Adjudged, ordered and decreed * * * that the said letters patent No. 499,769, granted June 20, 1893 to George Herbert Whittingham, as to claims 4, 5, 6, 7 and 8 thereof, is good and valid in law; and that defendant * * * has infringed upon claims 4 and 5 of said letters patent."

The decree granted an injunction and an accounting as to claims 4 and 5.

This decree is interlooutory.

Smith & Vulcan Works 165 U. S., 518.

(2.) *The second decree entered May 24, 1905, is interlocutory and not final.* This decree:

"Adjudged, ordered and decreed that the Bill of Complainant herein be, and the same hereby is dismissed as to claims 6, 7 and 8 of the Whittingham patent herein suit, as not being infringed by defendant."

This decree still left before the Circuit Court the accounting on claims 4 and 5 and the control of the injunction. The decree is therefore not a final decree.

Dowagiac Mfg. Co. *v.* Superior Drill Co., 115 Fed. 886.

Marden *v.* Campbell Printing Press & Mfg. Co., 67 Fed. 809.

Eagle Lock Co. *v.* Griswold, 67 Fed. 789.

Kilmer Mfg. Co. *v.* Griswold, 67 Fed. 1017.

Western Electric Co. *v.* Williams-Abbott Electric Co, 108 Fed. 952.

In patent causes there cannot be two final decrees.

Marden *v.* Campbell Co., *supra*.

(3) *Defendant appealed May 12, 1905, under sec. 7 of the Judiciary Act of 1891 before the second decree was entered.*

The subsequent entry of the second decree cannot therefore affect or enlarge the appeal from the first decree.

(4.) *Complainant appealed June 7, 1905, from the second decree entered May 24, 1905.*

This was an independent appeal from a supposed final decree and not a cross appeal.

(5.) *Complainant's appeal cannot be sustained as an independent appeal from a final decree*, because the second decree was interlocutory, since it did not dispose of the entire litigation.

(6.) *Complainant's appeal cannot be sustained as an independent appeal from an interlocutory decree*, since the decree of May 24, 1905, appealed from, *refuses* an injunction and is, therefore, not appealable under sec. 7.

(7.) *Complainant's appeal cannot be sustained as a cross appeal from the interlocutory decree of April 20, 1905*, because that decree is wholly in favor of complainant and is not adverse in any particular.

(8.) *Complainant's appeal cannot be sustained as a cross appeal based on the subsequent decree of May 24, 1905*, because that decree was entered *after* the appeal had been perfected by defendant as to the first interlocutory decree.

(9.) *The two decrees cannot, for the purpose of appeal, be considered as one appeal*, because the Circuit Court had lost jurisdiction of the first decree by defendant's appeal before the second decree was entered.

(10.) *At the date of complainant's appeal, defendant had not taken up a complete record*, or in fact any record;

after both appeals had been taken, a joint record was made up; therefore, at the date of complainant's appeal there was no complete record before the Court of Appeals upon which a cross-appeal could be based.

V.

In view of the above propositions it is apparent that the first of the three theories as to the nature of the three decrees is the only one which is tenable.

(1.) Both decrees are interlocutory; defendant could appeal from the first decree because it *granted* an injunction; complainant could not appeal from the second decree because it *refused* an injunction.

(2.) Complainant's appeal was taken on the theory that the second decree was *final* and would support an *independent* appeal; as the second decree was in fact interlocutory, not disposing of the entire litigation, the appeal on the theory that it was an independent appeal from a final decree was properly dismissed.

(3.) The main contention of the moving party before this court is that the two decrees constitute, in effect, one decree and that a cross appeal is therefore proper: but the second decree was entered *after* the appeal on the first decree and could not therefore alter or affect the rights of appeal based on the first decree.

But even though the subject matter of the two decrees were embraced in a *single* decree, the authorities relied upon do not support the moving party's position.

Smith vs. Vulcan Iron Works, 165 U. S., 518, was a case in which the patent was sustained as to *all* the claims in suit and injunction granted thereon. Upon appeal under sec. 7, of the Judiciary Act, the question arose as to whether the Court of Appeals was limited to a review of the pro-

priety of granting the injunction, whether improvident or not, or whether the court could go into the merits and consider also the question of validity and infringement and dismiss the bill if it found want of merits. It was held that the Court of Appeals had this authority.

In the present case the interlocutory decree of April 20, 1905, finds (1) validity and (2) infringement and (3) grants injunction as to claims 4 and 5 and contains no adverse finding as to the remaining claims in suit.

Therefore, under the doctrine of Smith *vs.* Vulcan Works, the Court of Appeals may consider the whole of this interlocutory decree and pass upon the validity and infringement of claims 4 and 5 as well as upon the propriety of granting the injunction.

But the moving party contends that Smith *vs.* Vulcan Works not only authorizes the Court of Appeals to pass upon the validity and infringement of the claims upon which an injunction is granted, but also, where the decree *refuses* an injunction as to other claims, to pass upon this question of *refusal* of injunction. This is an entirely different question from that presented in Smith *vs.* Vulcan Works. The Court of Appeals for the Seventh Circuit however, has interpreted Smith *vs.* Vulcan as authorizing such practice under certain conditions.

Chicago Co. vs. Miller Co. 133 Fed. Rep. 541 is the case in the Seventh Circuit. This case however, differs from the present case in two vital particulars.

(1.) In that case there was a *single* decree granting an injunction as to part of the claims and refusing an injunction as to the remainded; in this case there are *two* separate decrees, the second one, from which complainant appeals having been entered *after* the perfecting of the appeal on the first decree.

(2.) In that case defendant in perfecting its appeal from

the single decree brought up the *entire* record and *after* the entire record was before the appellate tribunal, complainant took a cross appeal; in the present case but a part of the record would have been taken up by defendant had the appeal by complainant not been taken. The patent exhibits and the evidence relating to claims 6, 7 and 8 were entirely different from those relating to claims 4 and 5 which were sustained and would not have been included in the record had not complainant appealed.

But even though the facts in the present case were the same as those in Chicago Co. *vs.* Miller Co., it is submitted that that case is not good law:

(1.) Because Smith *vs.* Vulcan Works is not authority for the doctrine set forth in Chicago Co. *vs.* Miller Co., and

(2.) Because Chicago Co. *vs.* Miller Co. is contrary to the express language of the Statute and the intent of Congress in enacting that Statute.

Smith *vs.* Vulcan Works is authority for the doctrine that where *all* of the claims in suit are sustained and an injunction is granted, the Court of Appeals has authority to consider the merits of the decree and pass upon the questions of validity and infringement as well as on the propriety of the injunction. It is not authority for the doctrine that where *part* of the claims are sustained and an injunction granted, while an injunction is *refused* as to the remaining claims, the Court of Appeals can pass upon the part refusing the injunction as well as upon the merits of the part granting the injunction.

Sec. 7, as originally enacted in 1891, was in the same form as at present, so far as the present issues are concerned; and granted an appeal where an injunction was granted but did not grant an appeal where an injunction was refused. A number of decisions were rendered holding that under this law the Court of Appeals would not

entertain a cross appeal by complainant to review that portion of the decree which refused the injunction.

In 1895 the section was amended evidently to avoid the effect of these decisions and the right was expresely granted to appeal from a decree refusing an injunction.

In 1900 the Act was again amended and the provision allowing appeal from a decree *refusing* an injunction was *striken out*, so that the Act now stands as it did in 1891, so far as present issues are concerned.

It was thus evidently the intent of Congress to re-establish the practice which had been fixed by the courts under the Act of 1891 and the language of the section is unequivocal.

It follows that the motion in both its aspects should be denied.

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